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EXAMINER
NOLAN, PATRICK J

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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Paper No. 15

Application Number: 09/871,388
Filing Date: May 31, 2001
Appellant(s): Rubin et al.

Richard Osman
For Appellant

EXAMINER'S ANSWER

This is in response to appellant's brief on appeal filed May 12, 2003.

Real Party in Interest.

A statement identifying the real party in interest is contained in the brief.

Related Appeals and Interferences.

The brief does contain a statement that Appellants are unaware of any related appeals or interferences

Status of Claims.

The statement of the status of the claims contained in the brief is correct.

Status of Amendments.

The appellant's statement of the status of amendments contained in the brief is correct.

Statement of Invention.

The summary of invention contained in the brief is correct.

Issues.

The appellant's statement of the issues in the brief is correct.

Grouping of Claims.

Appellant's brief includes a statement that claims 14-21 and 23-33 stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

Claims Appealed.

The copy of the appealed claims contained in the Appendix to the brief is correct.

References of record.

There are no references of record present to support the rejection of the instantly pending claims.

Grounds of rejections:

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 14-21 and 23-33 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession

of the claimed invention.

Appellant has no written support in the originally filed claims or specification for an antibody that binds to SEQ ID NOS 2, 4, 6 or 8 but does not specifically bind MADM. Appellant in response to the prior art rejection of claims 14, 17, 20, 21, 23, 25, 26 and 33 under 35 U.S.C. § 102(b) as being anticipated by Howard et al., added the new matter, by the insertion of a claim limitation in the base claim of wherein the antibody "distinguishes and does not specifically bind bovine mammalian disintegrin-metalloproteinase (MADM).", to improperly create a subgenus antibody claim.

Response to Appellant's arguments:

In response to the rejection Appellant has argued:

The presently pending claims are fully supported by the original specification at page 5, lines 20-31 and on page 8, line 18-p10, line 8.

However, pages 8-10 merely disclose how to make KUZ specific antibodies. There is no disclosure of antibodies which can bind to SEQ ID Nos 2, 4, 6 and 8 and not specifically bind the prior art protein MADM. Page 5 of the specification discloses how KUZ polypeptide binding targets can be assayed for, and included in the binding target determination assays are antibodies. The only disclosure of discrimination between KUZ and the prior art MADM is on lines 29-31 of page 5, which clearly discloses that "The KUZ binding specificity of preferred KUZ polypeptides necessarily distinguishes that of the bovine protein of Howard, L., et al. (1996). Biochem. J. 317, 45-50". If one reads the paragraph carefully, the antibodies are referred to in the paragraph as binding targets, while the actual enzymes, the KUZ polypeptides, are disclosed for distinguishing between the prior art bovine MADM and the disclosed KUZ polypeptides. Nowhere, does Appellant have written support for an antibody that can specifically bind to SEQ ID NOS 2, 4, 6 and 8 and not MADM.

Appellant argues that the objected-to limitation is inherent in a KUZ-specific antibody, that KUZ by definition must have binding specificity that distinguishes MADM and therefore KUZ binding specificity by definition includes binding of a KUZ specific antibody that must necessarily distinguish KUZ from MADM.

However, KUZ binding specificity, refers to the KUZ polypeptides, not their binding targets (i.e. antibodies).

Appellant argues the limitation of the claimed antibodies not specifically binding to MADM to be an inherent property of the antibodies.

However, the term specifically binds in the antibody art does not remove prior art antibodies from reading upon the claimed invention because of art recognized properties of antibody cross reactivity. In re Oelrich, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981) recognized that "To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.'.

As is clear from the prosecution history of the file wrapper the broad genus claims drawn to any antibody that specifically binds to SEQ ID NO. 2, 4,6 or 8 was anticipated by a prior art polyclonal antibody made against a peptide sequence FDANQPEGKKC that shares 100% homology with residues 486-496 of SEQ ID NO.8 and shares 9 of 10 amino acid residues with SEQ ID NOS 4 and 6 (page 47, 2nd column in particular).

Appellant in response added the new matter, by the insertion of a claim limitation in the base claim of wherein the antibody "distinguishes and does not specifically bind bovine mammalian disintegrin-metalloproteinase (MADM).", to improperly create a subgenus antibody claim.

For the above reasons, it is believed that the rejections should be sustained.

Respectively submitted,

Patrick J. Nolan, Ph.D.
Primary Examiner
August 6, 2003

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